

REMARKS

Applicants submit that by the present Amendment and Remarks, this Application is placed in clear condition for immediate allowance. At the least, the present Amendment places the Application in better condition for appeal.

Applicants also submit that the present Amendment does not generate any new matter issue, as adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, as, for example, page 21 of the written description of the specification, lines 13 through 16. Further, Applicants submit that the present Amendment does not generate any new issue because it merely clarifies that which one having ordinary skill in the art would have understood from properly interpreting the claims in light of and consistent with the written description of the specification, i.e., that the claimed plating bath precursor is employed for electroless plating. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. §1.116.

Claims 15 through 17 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Odanaka et al.

In the statement of rejection the Examiner asserted that Odanaka et al. disclose a plating bath corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art.

Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

There is a fundamental difference between the claimed plating bath precursor and the plating bath disclosed by Odanaka et al. that scotches the factual determination that Odanaka et al. disclose a plating bath identically corresponding to that claimed.

Initially, Applicants would note that Odanaka et al. is in a foreign language and the Examiner has not provided a complete English language translation of the underlying document. The Board of Patent Appeals and Interferences has repeatedly held that the Examiner is required to supply a complete English language translation of an applied underlying foreign document.

Ex parte Bonfils, 64 USPQ2d 1456 (BPAI 2003); *Ex parte Gavin*, 62 USPQ2d 1680 (BPAI 2001); *Ex parte Jones*, 62 USPQ2d 1206 (BPAI 2001). On this basis alone, the imposed rejection should be withdrawn.

Furthermore, as pointed out above, there is a fundamental difference between the claimed plating bath and the plating bath disclosed by Odanaka et al. that undermines the factual determination of lack of novelty under 35 U.S.C. §102. Specifically, as one having ordinary skill in the art would have understood, even prior to the present Amendment, the claimed plating bath precursor is employed for electroless plating. In other words, it is an electroless plating bath.

On the other hand, the plating bath disclosed by Odanaka et al. is an **electroplating** bath. As apparent from the present disclosure, for example, page 1 of the written description of the specification, lines 9 et seq., electroplating baths and electroless plating baths are recognized as fundamentally different types of plating baths.

The above argued fundamental difference between the claimed **electroless** plating bath and the **electroplating** bath disclosed by Odanaka et al. undermines the factual determination that Odanaka et al. disclose a plating bath identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24

USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230

USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 15 through 17 under 35 U.S.C. §102 for lack of novelty as evidenced by Odanaka et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 15 through 17 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Triani et al.

In the statement of rejection the Examiner asserted that Triani et al. disclose a method identically corresponding to that claimed, referring to, *inter alia*, column 8, lines 30 through 40. This rejection is traversed.

As previously argued, the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc., supra; Crown Operations International Ltd. v. Solutia Inc., supra.* There is also a fundamental difference between the claimed plating bath and the plating bath disclosed by Triani et al. that scotches the factual determination that Triani et al. disclose a plating bath identically corresponding to that claimed.

Specifically, as one having ordinary skill in the art would have recognized even prior to the present Amendment, and particularly with the present Amendment, the claimed plating bath is an electroless plating bath precursor. On the other hand, the plating bath disclosed by Triani et al. is an **electroplating** bath. As also previously argued, there is a recognized difference in the art between an electroless plating bath and an electroplating bath.

The above argued fundamental difference between the claimed electroless plating bath and the electroplating bath disclosed by Triani et al. undermines the factual determination that Triani et al. disclose a plating bath identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra*; *Kloster Speedsteel AB v. Crucible Inc., supra*.

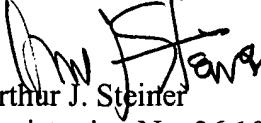
Applicants, therefore, submit that the imposed rejection of claims 15 through 17 under 35 U.S.C. §102 for lack of novelty as evidenced by Triani et al. is not factually viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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